

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT: P. Bonsignore and M. Gurin
SERIAL NO.: 10/027,387
FILING DATE: December 20, 2001
TITLE: COMPOSITION FOR ENHANCING THERMAL
CONDUCTIVITY OF A HEAT TRANSFER MEDIUM AND
METHOD OF USE THEREOF

ATTORNEY DKT NO.: 6037-001

FAX RECEIVED

Assist. Commissioner for Patents
BOX PETITIONS - FILING DATE
Washington, D.C. 20231

FEB 25 2002

PETITIONS OFFICE

CERTIFICATE OF FACSIMILE TRANSMITTAL

I hereby certify that the attached document and any being referred to as enclosed and/or attached are being transmitted on this the 22nd day of February, 2002 to the Assist. Commissioner of Patents, BOX PETITIONS, Washington, D.C. 20231, at (703) 308-6916.


Lori Dunham

**CONSOLIDATED PETITIONS UNDER 37 CFR §1.183 TO WAIVE CERTAIN
EXPRESS MAIL FILING PROCEDURES UNDER 37 C.F.R. 1.10
AND PETITION FOR CORRECTED FILING DATE PURSUANT TO 37 C.F.R. 1.10**

Dear Sir:

Pursuant to 37 C.F.R. §1.183, Applicant hereby petitions the Commissioner to waive the requirements of 37 C.F.R. §1.10 that requires a Petition to Grant Express Mail Filing Date under 37 C.F.R. §1.10(d) be supported by a satisfactory showing that "the correspondence was deposited in the "Express Mail Post Office to Addressee" service prior to the last scheduled pickup for that day." 37 C.F.R. 1.10(d)(3).

06/14/2002 AKELLEY 00000026 182000 10027387

01 FC:122 130.00 CH

Applicant hereby petitions pursuant to 37 C.F.R. §1.10(d) that a filing date of December 19, 2001 be granted rather than the filing date accorded of December 20, 2001. As reflected in the accompanying Declarations of David G. Rosenbaum, Lori Dunham and Laura A. Molter, the subject patent application was actually deposited with the United States Postal Service at 433 W Harrison St, Chicago, IL 60607 prior to 11:59 p.m. on December 19, 2001. However, due to understaffing at the post office, combined with the Christmas holiday mailing rush, timely delivery of the patent application to a postal service employee prior to 11:59 p.m. on December 19, 2001 was impossible. Additionally, the United States Post Office at which the deposit was made is the main post office for the City of Chicago and the only twenty-four hour facility in the Chicago metropolitan region. At the main Chicago post office, the last pick up from any Express Mail drop box was observed to be 9:00 p.m. Accordingly, after 9:00 p.m. and before 11:59 p.m. the only possible manner for complying with 37 C.F.R. §1.10 is to actually deliver the filing with a postal service employee. However, as attested to in the accompanying declaration of David G. Rosenbaum, such delivery was impossible due to the situation existing at the Post Office prior to 11:59 p.m. on December 19, 2001 which left deposit in the drop box the only option for filing the subject application.

Applicant respectfully requests the Commissioner invoke the provisions of 37 C.F.R. 1.183 and find that an extraordinary situation exists and that justice requires waiver of the requirement of a satisfactory showing that "the correspondence was deposited in the "Express Mail Post Office to Addressee" service prior to the last scheduled pickup for that day" under 37 C.F.R. 1.10(d)(3) to support a Petition to Grant a Corrected Filing Date of December 19, 2001. This Petition is being filed with the appropriate petition fee as required by 37 C.F.R. 1.17(h) as required by 37 C.F.R. §1.183.

37 C.F.R. §1.10(a) provides that "[a]ny correspondence received by the Patent and Trademark Office (Office) that was delivered by the "Express Mail Post Office to Addressee" service of the United States Postal Service (USPS) will be considered filed in the Office on the date of deposit with the USPS." Thus, it is the intent of the regulation that date of deposit with the USPS controls the granting of the filing date by the U.S. Patent and Trademark Office. In determining the date of deposit, either the "date-in" on the Express Mail mailing label or "other

official USPS notation" may be used as reference. However, where the Office received correspondence deposited with the USPS as "Post Office to Addressee" as in the present case, 37 C.F.R. §1.10(d) also permits introduction of other evidence which constitutes a "showing which establishes, to the satisfaction of the Commissioner, that the requested filing date was the date the correspondence was deposited in the "Express Mail Post Office to Addressee" service prior to the last scheduled pickup for that day." Thus, the rule contemplates that evidence other than the "date in" on the Express Mail mailing label will be considered as supporting a petition to grant a filing date inconsistent with the "date-in" on the mailing label.

37 C.F.R. §1.10 is silent, in its entirety, as to situations like the present case, where it is impossible to deposit correspondence with a postal service employee, after attempt to do so is made, and no drop box is available that has any scheduled pick ups prior to 11:59 p.m. of a particular date of deposit, yet deposit with the Postal Service via a drop box is still possible prior to 11:59 p.m. Applicant respectfully suggests that in such situations, it is within the Commissioner's sound discretion to consider other satisfactory evidence supporting deposit of correspondence with the United States Postal Service as Express Mail "Post Office to Address" on a date different than that noted by the USPS.

This Petition is being filed promptly after becoming aware that the Office has accorded a filing date based upon an incorrect entry by the USPS, the Express Mail mailing label number was placed on the papers that constituted the entire correspondence, and this Petition is being filed with an evidentiary showing supported by the Declarations of three individuals at the undersigned's office who were involved in the preparation and deposit of the correspondence with the USPS, and corroborated by correspondence generated by the USPS within one business day of the date of deposit.

As supported by the Declaration of David G. Rosenbaum, and the return receipt post card, Applicant by David G. Rosenbaum, actually deposited the above-identified patent application in an official mail drop box at the main Chicago U.S. Post Office at 433 W Harrison

St, Chicago, IL 60607 at 11:51 p.m. December 19, 2001. As attested to by the Declaration of David G. Rosenbaum and the time stamp on the directory print-out from the office network server, he completed revisions to the patent application at approximately 10:36 p.m. on December 19, 2001. As attested to by the Declarations of Lori Dunham and Laura A. Molter, both employees of Rosenbaum & Associates, P.C., Ms. Dunham completed the patent application correspondence, including the patent application transmittal documents, return receipt post card and filing fee at approximately 10:45 p.m. as represented by the time stamp on the directory listing for file PH00GE.dbt, which is the data file for the firm's PTO form program "IP Legal Forms" that corresponds to Matter No. 6037-001 prepared on December 19, 2001. Dunham Dec. Exhibit 1.

Ms. Dunham completed the Express Mail filing packages for both the above-referenced patent application and a corresponding PCT International Application at approximately 11:30 p.m., at which time Mr. Rosenbaum and Ms. Molter left the offices of Rosenbaum & Associates, P.C. and drove to the United States Post Office at 433 West Harrison in Chicago. The distance from Mr. Rosenbaum's office to the U.S. Post Office is approximately 2.5 miles and traverses downtown Chicago. Mr. Rosenbaum & Ms. Molter arrived at the U.S. Post Office at approximately 11:45 p.m. and Mr. Rosenbaum walked to the transaction counters at the Post Office. See, Molter Declaration. When he arrived at the transaction counters, it was 11:50 p.m., and Mr. Rosenbaum found an extraordinarily long line of persons, approximately 20-25 persons, with multiple Holiday packages and only one Postal employee on duty. Mr. Rosenbaum inquired of a security guard whether any other Postal employees were on duty to accept the Express Mail package, and when informed that there were not, Mr. Rosenbaum determined that it would be impossible to wait in this line and still make the deposit prior to 11:59 p.m. on December 19, 2001. Accordingly, Mr. Rosenbaum placed the Express Mail package containing the patent application, supporting transmittal letter, filing fee, return receipt post card, all bearing the Certificate of Mailing under 37 C.F.R. §1.10 signed by Ms. Dunham, in the drop box in order to effectuate a deposit with the U.S. Post Office on the date specified and certified in the Certificate of Mailing under 37 CFR §1.10. Mr. Rosenbaum checked the last pick up time for

the drop box and it was indicated on the box that the last pick up time was 9:00 p.m. Mr. Rosenbaum ascertained that there were no other drop boxes available. Thus, Mr. Rosenbaum actually deposited the Express Mail package, postage prepaid, under a Post Office to Addressee Mailing Label addressed to Commissioner of Patents, Washington, D.C. 20231 with the United States Postal Service at 11:51 p.m. according to Mr. Rosenbaum's wristwatch.

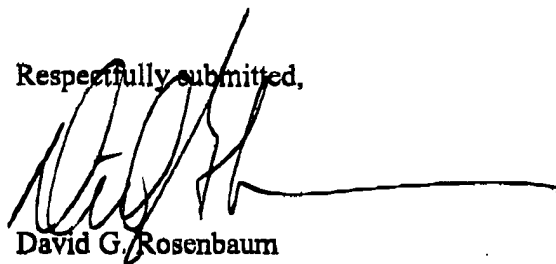
On January 14, 2002, Mr. Rosenbaum's Office received the Return-Receipt postcard, a copy of which is attached as Exhibit 2 to Ms. Dunham's Declaration, that indicated that the application had been accorded a filing date of December 20, 2001. As of that date, Mr. Rosenbaum's Office had not received from the U.S. Postal Service the sender's copy of the Express Mail mailing label. Therefore, Ms. Dunham tracked Express Mail Label No. EL 412126401US with the USPS web site www.usps.gov and ascertained that the subject patent application was accepted at 12:23 a.m. on December 20, 2001 at Chicago, IL 60607 and arrived on December 26, 2001 at ZIP code 20096. As a direct result of this Applicant's patent application received a filing date of December 20, 2001. This information appeared inaccurate as the Express Mail was addressed to the Commissioner at zip code 20231. A check of www.usps.gov indicates that there is no assigned zip code for 20096 the delivery address of the subject patent application. After waiting for the USPS records to be correctly updated, on January 24, 2002, Mr. Rosenbaum ordered an official receipt from the USPS via its web site www.usps.gov which was sent to Mr. Rosenbaum on the same date. A true and correct copy of that official receipt is attached to Mr. Rosenbaum's Declaration as Exhibit 2. The official receipt, however, indicates that the USPS was unable to locate any delivery information in their records corresponding to Item Number EL412126401US. There is, therefore, an obvious discrepancy between the tracking information provided by the USPS on its web site www.usps.gov and the official receipt dated January 24, 2001. The tracking information provided from the www.usps.gov is, however, consistent with Mr. Rosenbaum's attested time and date of deposit, i.e., December 19, 2001 at 11:51 p.m. with a pick up by the USPS at 12:23 a.m. on December 20, 2001, thirty-two minutes later. Applicant respectfully submits, therefore, that the tracking information provided by the USPS web site is a communication generated by

the USPS within one business day of the date of deposit which corroborates Mr. Rosenbaum's date and time of deposit on December 19, 2001 at 11:51 p.m.

Due to the extraordinary and unforeseeable circumstances which were encountered at the U.S. Post Office, Applicant requests that the Commissioner waive the requirement for deposit in a drop box prior to the last pick up time where the actual date and time of deposit were after the last pick up from the drop box and prior to 11:59 p.m. and where timely actual deposit with a postal service employee is not possible, and grant Applicant's above-reference application a filing date of December 19, 2001 the actual date of deposit with the United States Postal Service.

Applicant authorizes the Petition fee of \$130.00 set forth in 37 CFR §1.17(h) to be deducted from Deposit Account 18-2000. The Commissioner is authorized to deduct any deficiencies in fees from Deposit Account 18-2000.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'D. Rosenbaum', with a long horizontal line extending to the right.

David G. Rosenbaum

February 15, 2002

ROSENBAUM & ASSOCIATES, P.C.
875 North Michigan Avenue
Suite #3653
Chicago, Illinois 60611
(312) 397-0303 Telephone
(312) 397-0301 Facsimile
drosenbaum@biopatentlaw.com

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT: P. Bonsignore and M. Gurin
SERIAL NO.: 10/027,387
FILING DATE: December 20, 2001
TITLE: COMPOSITION FOR ENHANCING THERMAL CONDUCTIVITY OF
A HEAT TRANSFER MEDIUM AND METHOD OF USE THEREOF
ATTORNEY DKT NO.: 6037-001

Assist. Commissioner for Patents
BOX PETITIONS - FILING DATE
Washington, D.C. 20231

FAX RECEIVED

FEB 25 2002

PETITIONS OFFICE

**DECLARATION OF DAVID G. ROSENBAUM
IN SUPPORT OF CONSOLIDATED PETITIONS UNDER 37 CFR §1.183 TO WAIVE
CERTAIN EXPRESS MAIL FILING PROCEDURES UNDER 37 CFR §1.10 AND
PETITION FOR CORRECTED FILING DATE PURSUANT TO CFR §1.10**

1. I am the attorney of record in the above-identified patent application.
2. I completed revisions to the above-identified patent application at approximately 10:34 p.m on December 19, 2001 and gave the final version of the patent application to my paralegal, Lori Dunham, for completion of all patent application correspondence, as represented by the time stamp on the directory listing for the file ENHANC~2 DOC., which is the document file for the firm's word processing program that corresponds to Matter No. 6037-001, which is attached hereto as Exhibit 1.
3. Ms. Dunham completed the patent application correspondence, including the patent application transmittal documents, return receipt post card and filing fee at approximately 10:45 p.m. as represented by the time stamp on the directory listing for file PH00GE.dbt, which is the data file for the firm's PTO form program "IP Legal Forms" that corresponds to Matter No. 6037-001 prepared on December 19, 2001. (Dunham Dec. Exhibit 1)

4. After completion of all patent correspondence, Ms. Dunham provided the documents to myself for review and signature. After reviewing and signing all documents, I returned them to Ms. Dunham to be photocopied and readied for filing.
5. Ms. Dunham completed the Express Mail filing packages for both the above-referenced patent application and a corresponding PCT International Application at approximately 11:30 p.m., at which time I left the offices of Rosenbaum & Associates, P.C., accompanied by Ms. Laura Molter, and drove to the United States Post Office at 433 West Harrison in Chicago.
6. The distance from my office to the U.S. Post Office is approximately 2.5 miles and traverses downtown Chicago.
7. Ms. Molter and I arrived at the U.S. Post Office at approximately 11:45 p.m. and walked to the transaction counters at the Post Office. I observed from a clock at the post office that it was 11:50 pm when I arrived at the transaction counters.
8. Upon arrival at the transaction counters, I found an extraordinarily long line of approximately 20-25 persons, with multiple Holiday packages, and only one Postal employee on duty. I approached the security guard at the entrance and inquired whether any other Postal employees were on duty to accept the Express Mail package and was informed that there were not. I determined that it would be impossible to wait in this line and still make the deposit prior to 11:59 p.m. on December 19, 2001 and walked directly to the Express Mail drop box. I checked the last pick up time for the drop box and it was indicated on the box that the last pick up time was 9:00 p.m. I inquired and learned that there were no other drop boxes available with a last pick up that would have been later than 9:00pm.
9. Accordingly, I placed the Express Mail package containing the patent application, supporting transmittal letter, filing fee, return receipt post card, all bearing the Certificate of Mailing under 37 C.F.R. §1.10 signed by Ms. Dunham, in the drop box in order to effectuate a deposit with the U.S. Post Office on the date specified and certified in the Certificate of Mailing under 37 C.F.R. §1.10.

I actually deposited the Express Mail package with the United States Postal Service at 11:51 p.m. according to my wristwatch.

10. On January 14, 2002, the Return-Receipt postcard, a copy of which is attached as Exhibit 2 to Ms. Dunham's Declaration, was received in my office. The postcard indicated that the application had been accorded a filing date of December 20, 2001. As of that date and as of the date of this Declaration, we had not received the sender's copy of the Express Mail mailing label from the U.S. Postal Service.
11. Ms. Dunham tracked Express Mail Label No. EL 412126401US with the USPS web site www.usps.gov and ascertained that the subject patent application was accepted at 12:23 a.m. on December 20, 2001 at Chicago, IL 60607 and arrived on December 26, 2001 at ZIP code 20096. A copy of tracking confirmation information from www.usps.gov is attached hereto as Exhibit 2. This information appeared inaccurate as the Express Mail was addressed to the Commissioner at ZIP code 20231.
12. I checked the U.S. Postal Service web site which indicates that there is no assigned zip code 20096, which is listed as the delivery address of the subject patent application. A copy of the Zip + 4 Code Look-up information is attached as Exhibit 3.
13. After waiting for the USPS records to be correctly updated, on January 24, 2002, I ordered an official receipt from the USPS via its web site www.usps.gov which was sent to me via facsimile on the same date. A true and correct copy of that official receipt is attached to as Exhibit 4. The official receipt indicates that the USPS was unable to locate any delivery information in their records corresponding to Item Number EL412126401US.
14. I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both,

under 18 U.S.C. 1001 and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

A handwritten signature in black ink, appearing to read 'D. Rosenbaum', is written over a horizontal line.

David G. Rosenbaum
Reg. No. 31,872